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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,748

03/17/2004

Dana M. Walker

100041-41199

6866

66061 7590 12/03/2009
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EXAMINER

KATCOFF, MATTHEW GORDON

ART UNIT

PAPER NUMBER

3725

NOTIFICATION DATE

DELIVERY MODE

12/03/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketadministrator@mwv.com

Office Action Summary	Application No. 10/803,748	Applicant(s) WALKER ET AL.	
	Examiner Matthew G. Katcoff	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-17,19-31,34-36,38,39 and 41-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-17,19-31,34-36,38,39 and 41-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 31 August 2009 has been entered and is sufficient to overcome the prior art rejections. A new set of rejections as necessitated by the amendment is recited below. Claims 7, 8, 18, 27, 32, 33, 37, 40, 42 and 46-49 have been canceled. Claims 1-6, 9-17, 19-26, 28-32, 34-36, 38, 39, 41 and 43-45 are currently pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 19 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "cutout" has no basis in the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 9 recites the limitation "...said slit edge is pivotable about said crease."

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 11-17, 19-26, 28-31, 35-36, 39 and 43-45 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,614,450 to Neiman (*Neiman*) in view of U.S. Patent No. 5,080,223 to Mitsuyama (*Mitsuyama*), U.S. Patent No. 4,345,394 to Sullivan (*Sullivan*) and U.S. Patent No. 2,333,798 to Kner (*Kner*).

Concerning claims 1 and 2, *Neiman* discloses a system comprising at least one storage sheet (10) having at least two pockets (pockets 18 used for storing index cards) in a notebook (figure 1) having a front and back cover and a binding mechanism (16). *Neiman* further discloses that the pockets are transparent (abstract). *Neiman* does not however disclose the storage sheet having a backing sheet, a panel pocket between the at least one card pocket and the backing sheet and including at least one supply sheet having a plurality of index cards formed therein and detachable therefrom.

Mitsuyama teaches having a storage sheet having a backing sheet (32) and a panel pocket (37) between at least one pocket (43) and the backing sheet (figure 8-9) as well as a mouth and a flap for selectively covering the mouth (figure 8, flap 35).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the panel pocket and backing as taught by *Mitsuyama* with the storage sheet of *Neiman* for the purpose of providing additional storage.

Sullivan teaches having a supply sheet (figure 3) capable of being bound in a notebook via binding edge (36) and having at least one detachable index card thereon with perforations (figure 3), the cards of *Sullivan* satisfy the requirement of being "index cards" in that they can be filed, as in the pockets in figure 2 for example and they can receive text).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the supply sheet of *Sullivan* with the system of *Neiman* modified by *Mitsuyama* for the purpose of allowing the user to store both the index cards and the supply sheet together, especially since *Sullivan* teaches assembling both a supply sheet and pocket sheet in a binder (column 1 lines 40-43 of *Sullivan*).

Regarding the sizing of the card pockets and index cards, it would have been an obvious matter of design choice to size the pockets and index cards as claimed since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). It is noted that applicant provides no criticality to the size of the pockets or cards (specification page 4 paragraph 0021).

Finally, neither *Neiman* nor *Mitsuyama* nor *Sullivan* teaches the card pocket having a slit for receiving said flap.

Kner teaches a flap (6) and a front panel (2) which includes a cutout (24) and along the lower edge of said cutout being a slit (23) for receiving part of the flap (7) to retain the flap in a closed position wherein said flap generally covers said mouth (figure 1) wherein said slit extends laterally beyond said cutout (figure 2).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the flap and mouth disclosed by *Mitsuyama* with the flap and mouth disclosed by *Kner* because this is simply the substitution of one known technique for closing a flap for another with predictable results.

Concerning claim 3 wherein the system further comprises a plurality of sheets of paper bound by the binding mechanism. It is well known to provide sheets of paper in a notebook. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sheets of paper in the notebook of *Neiman* (modified by *Mitsuyama*, *Sullivan* and *Kner*) for the purpose of providing the user with sheets for writing information thereon.

Regarding the limitations of claim 4 wherein the supply sheet is similar in shape but generally smaller than the sheets of paper and the limitations of claims 12, 14-16 wherein the index cards are of a specific size, it is well known to have

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paper or index cards of various sizes therefore it would have been obvious to one having ordinary skill in the art that the time the invention was made to alter the size of the sheet as suited for the intended use, especially since applicant has provided no criticality towards the size of the paper (page 6 paragraph [0026] of spec.) nor the size of the index cards (page 4 paragraph [0021] last 5 lines of spec.).

Regarding claim 5, *Neiman* discloses in figure 1 a front cover and a back cover (17) and the covers are bound to the sheets by a binding mechanism (14, 15 and 16)

Regarding the limitations of claim 6 wherein the binding mechanism is a helical coil or twin wire, *Neiman* uses binding rings as the binding mechanism but helical coil and twin wire binders are also a well known binding mechanism. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a well known helical coil binder for the purpose of binding the sheets together, since binding rings and helical coil binders are art recognized equivalents.

Concerning claim 9, *Kner* discloses the slit edge is pivotable about a crease (page 2, column 2, lines 13-22).

Concerning claim 10, *Kner* discloses the slit edge forms an angle with a body of said pocket and is shaped to guide said flap there under (figure 1).

Regarding claim 11, *Neiman* (modified by *Mitsuyama*, *Sullivan* and *Kner*) discloses having two pockets being rectangular in shape and the first pocket

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having a longitudinal axis. *Neiman* (modified by *Mitsuyama, Sullivan and Kner*) does not however disclose that the second rectangular pocket has a longitudinal axis perpendicular to the axis of the first pocket. However changing the size of the pocket such that the longitudinal axis of the second pocket is perpendicular to the axis of the first pocket would be an obvious matter of design choice. This modification would allow for storing index cards of different sizes.

Regarding claim 13, *Neiman* (modified by *Mitsuyama, Sullivan and Kner*) discloses the index card being formed on the supply sheet by a plurality of perforations in the supply sheet (figure 3 of *Sullivan*).

Regarding claim 17, *Neiman* (modified by *Mitsuyama, Sullivan and Kner*) discloses the pocket being made of a generally entirely transparent material (abstract and figure 3 of *Neiman*). *Neiman* (modified by *Mitsuyama, Sullivan and Kner*) also satisfies the method for assembling an index card storage system, recited in claims 19-26.

Concerning claims 19 and 20, the method disclosed is inherent in the system of claim 1 and 2 and is thus rejected on at least the same grounds as claims 1 and 2 are rejected above.

Concerning claim 21, the method disclosed is inherent in the system of claim 3 and is thus rejected on at least the same grounds as claim 3 is rejected above.

Concerning claim 22, the method disclosed is inherent in the system of claim 3 and is thus rejected on at least the same grounds as claim 3 is rejected above.

Concerning claim 23, the method disclosed is inherent in the system of claim 12 and is thus rejected on at least the same grounds as claim 12 is rejected above.

Concerning claim 24, the method disclosed is inherent in the system of claim 15 and is thus rejected on at least the same grounds as claim 15 is rejected above.

Concerning claim 25, the method disclosed is inherent in the system of claim 13 and is thus rejected on at least the same grounds as claim 13 is rejected above.

Concerning claim 26, the method disclosed is inherent in the system of claim 17 and is thus rejected on at least the same grounds as claim 17 is rejected above.

Regarding the method steps of claim 28, *Neiman* teaches providing a storage sheet with a pocket thereon and a binding mechanism and a teaching of placing index cards in the pockets (*Neiman* figure 3). *Mitsuyama* teaches providing a storage sheet having a backing sheet (32) and a panel pocket (37) between at least one pocket (43) and the backing sheet (figures 8-9 of *Mitsuyama*). *Sullivan* teaches having a supply sheet with detachable index cards thereon and placing the detached card in a pocket (*Sullivan* figure 2). Therefore it

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would have been obvious to place the index card of Sullivan in the pocket of *Neiman* modified by *Mitsuyama* for the purpose of providing safe storage of the card.

Regarding claim 29, the method discloses is disclosed by claims 19 and 28 and thus claim 29 is rejected on at least the same grounds as claims 19 and 28 are rejected above.

Regarding claim 30, see rejection of claim 18 above.

Regarding claim 31, see rejection of claim 17 above.

Regarding claim 35, see rejection of claim 13 above.

Regarding claim 36, see rejection of claim 17 above.

Regarding claim 39, see rejection of claim 17 above.

Regarding claims 43-45, *Neiman* modified by *Mitsuyama* and *Sullivan* disclose each of the index cards has a front and back surface (figure 3 of *Sullivan*- only front shown), wherein when the index card is placed in the card pocket at least the front is entirely visible (both *Neiman* and *Mitsuyama* disclose transparent pockets (abstract of *Sullivan*, column 2 lines 37-41 of *Mitsuyama*).

8. Claims 34, 38 and 41 rejected under 35 U.S.C. 103(a) as being unpatentable over *Neiman* in view of *Mitsuyama*, *Sullivan* and *Kner* as applied above and in further view of U.S. Patent No. 6,652,178 to Walton (*Walton*).

Concerning claim 34, the combination of *Neiman* in view of *Mitsuyama*, *Sullivan* and *Kner* does not disclose said plurality of card pockets are spaced apart in a generally co-planar, non-overlapping configuration.

Walton discloses wherein said plurality of card pockets (20) are spaced apart and arranged in a generally co-planar, non-overlapping configuration (figures 1, 2 and 5D).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the card pockets of *Neiman* to be in a generally co-planar, non-overlapping configuration because, as disclosed by *Walton* this is another way of arranging card pockets and is thus an obvious variation. This combination would be a simple substitution of one known way of arranging card pockets for another with predictable results.

Regarding claim 38, see rejection of claim 34 above.

Regarding claim 41, see rejection of claim 34 above.

9. Claims 1, 19, 29, 34, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Walton* in view of *Mitsuyama*, *Sullivan* and *Kner*.

Walton discloses a storage system having at least one storage sheet (figure 1) with at least two pockets that is to be bound in a notebook binder (abstract). *Walton* further discloses that the pocket includes a mouth and flap (figures 7a-d) and having a plurality of pockets spaced apart and arranged in a generally co-planar, non-overlapping relation (figure 7d). *Walton* however fails to disclose the backing sheet and panel pocket and a supply sheet having an index card formed therein and detachable therefrom and a binding mechanism for binding the sheet together with the storage sheet.

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Mitsuyama teaches having a storage sheet having a backing sheet (32) and a panel pocket (37) between at least one pocket (43) and the backing sheet (figures 8-9) as well as a mouth and a flap for selectively covering the mouth (figure 8, flap 35).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the panel pocket and backing as taught by *Mitsuyama* with the storage sheet of *Walton* for the purpose of providing additional storage. *Sullivan* teaches having at least one supply sheet having a plurality of index cards formed therein and detachable therefrom (figure 3 of *Sullivan*) and that has a binding edge (28) to be bound in a notebook (column 1 lines 40-43 of *Sullivan*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the storage sheet and binding mechanism (notebook) as taught by *Walton* with the supply sheet and binding edge of *Sullivan* modified by *Mitsuyama* for the purpose of providing storage for both the supply and storage sheets. Regarding the sizing of the card pockets and index cards, it would have been an obvious matter of design choice to size the pockets and index cards as claimed since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). It is noted that applicant provides no criticality to the size of the pockets or cards (specification page 4 paragraph 0021).

Finally, neither *Walton* nor *Mitsuyama* nor *Sullivan* teaches the card pocket having a slit for receiving said flap.

Kner teaches a flap (6) and a front panel (2) which includes a cutout (24) and along the lower edge of said cutout being a slit (23) got receiving part of the flap (7) to retain the flap in a closed position wherein said flap generally covers said mouth (figure 1) wherein said slit extends laterally beyond said cutout (figure 2).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the flap and mouth disclosed by *Mitsuyama* with the flap and mouth disclosed by *Kner* because this is simply the substitution of one known technique for closing a flap for another with predictable results.

Concerning claims 19 and 29, *Walton* modified by *Mitsuyama* and *Sullivan* further discloses the method of assembling an index card storage system.

Regarding the sizing of the card pockets and index cards, it would have been an obvious matter of design choice to size the pockets and index cards as claimed since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). It is noted that applicant provides no criticality to the size of the pockets or cards (specification page 4 paragraph 0021).

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Concerning claim 34, *Walton* discloses wherein said plurality of card pockets (20) are spaced apart and arranged in a generally co-planar, non-overlapping configuration (figures 1, 2 and 5D).

Regarding claim 38, see rejection of claim 34 above.

Regarding claim 41, see rejection of claim 34 above.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 19 and 29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew G. Katcoff whose telephone number is (571) 270-1415. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571) 272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725

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11/24/09